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Juan Amengual

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EXAMINER

ARAQUE JR, GERARDO

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/078,142	<b>Applicant(s)</b> AMENGUAL ET AL.	
	<b>Examiner</b> Gerardo Araque Jr.	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1 – 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. **Claim 1** recites the limitation "**said user specified Internet websites' proprietors**" in **line 7 of claim 1**. There is insufficient antecedent basis for this limitation in the claim.

5. **Claim 1** recites the limitation "**websites' proprietors**" in **line 18 of claim 1**. There is insufficient antecedent basis for this limitation in the claim.

6. **Claim 14** recites the limitation "**website's proprietors**" in **line 12 of claim 14**. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1 – 5, 7 – 20, 22 – 26 and 81 – 82** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pant et al. (US Patent 6,012,053)**.

9. In regards to **claims 1, 7, 14, 15, 16, 22, 81, and 82**, **Pant** discloses a customizable computerized system for providing access to specified Internet websites and comparable alternative websites utilizing telephone numbers as search queries, comprising:

an electronic data storage device for storing data comprising Internet domain names for available websites including said user specified Internet website and one or more additional websites, telephone numbers corresponding to said user specified Internet websites' proprietors, telephone numbers corresponding to said one or more additional websites' proprietors, and data regarding products or services offered by said user specified Internet website and said one or more additional websites in a database **(Col. 3 Lines 25 - 27)**;

an electronic communications network server for system users to communicate with said system via an electronic communications network **(Col. 3 Lines 15 – 31)** and

for receiving a system user search query for said user specified Internet website in the form of a telephone number corresponding to said user specified website's proprietor **(Col. 3 Lines 33 – 34)**;

one or more software applications for correlating said Internet domain name data for said user specified Internet website and said one or more additional websites with said telephone number data corresponding to said websites' proprietors, processing

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said user search query to provide access to said user specified Internet website in response to said user telephone number query, said one or more software applications further selecting one or more of said one or more additional websites that offer products or services similar to products or services offered by said user specified Internet website via a comparison of said data regarding products or services offered by said user specified website with said data regarding products or services offered by said one or more additional websites using **(Col. 3 Lines 33 – 41; Col. 5 Lines 22 – 25)**;

customizable criteria for comparison of said user specified website with said one or more additional websites and **(Col. 1 Lines 53 – 56; Col. 3 Lines 20 – 22)**;

providing, in response to said user telephone number query, a referential directory of said additional website offering products or services similar to products or services offered by said user specified Internet website based on said comparison of said data regarding products or services offered by said specified website and said one or more additional websites, in addition to said specified Internet website, said one or more additional Internet websites being further selected based on said customizable criteria, said referential directory listing both the website name and telephone number for said one or more additional Internet websites **(Col. 3 Lines 34 - 37)**; and

a computer processing device communicating with said electronic data storage device and said electronic communications network server and for running said one or more software applications to cause said user queries to be processed and said referential directory to be generated and rendered in response to said user queries **(Col. 3 Lines 15 – 32; see also Figures 1 – 3)**.

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However, **Pant** fails to explicitly disclose a specific search query, i.e. telephone numbers.

However, it would have been obvious to one having ordinary skill in the art that a search query can consist of many different types of alpha/numeric search terms. That is to say, a search query can consist of words, numbers, symbols, and/or any combination thereof. As a result, the Examiner asserts that it is well known that a user who would be using an Internet search engine to look up the location of say, a fast food establishment within a certain area code would input **area code 703 and burgers**, for example. Further still, it is also well known for the URL of many websites to be the phone number of the business, such as **1-800-FLOWERS (1-800-356-9377)** or **1-800-MATTRES (1-800-628-8737)**. As a result, the Examiner notes that the act of claiming a specific search term, i.e. telephone number, is nonfunctional descriptive subject matter. The Examiner asserts that the mere act of storing, retrieval, matching, and displaying data is non-functional. In other words, the type of data add little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the data type. Since **Pant** discloses the use of a search engine over the Internet and since it is well established that search terms can consist of various alpha/numeric combinations it would have been obvious that a telephone number can easily be substituted into the search query. Consequently, given the nature of how a search engine works it would have been realized by one having ordinary skill in the art that as long as the telephone number appears on a website the websites that contain

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the telephone number will appear in the search results. Moreover, an additional feature of a search engine is to also provide comparable websites that are associated with the search query (**see also Fig. 5 - 7 of Pant**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of **Pant** to use specific search terms, such as a telephone number, for when the user is searching for a specific site on the Internet.

10. In regards to **claims 2 and 17**, the Examiner asserts that it is old and well known to use web address forwarding.

11. In regards to **claims 3 and 18**, **Pant** discloses means for displaying to users content from said Internet websites in a standardized format (**Col. 6 Lines 40 – 50**)

12. In regards to **claims 4 and 19**, **Pant** discloses wherein said customizable criteria are provided by electronic communication from said user (**obviously included since the searching is being done on a computer; See also at least Col. 2 Lines 25 - 30**).

13. In regards to **claims 5 and 20**, **Pant** discloses wherein said customizable criteria are preprogrammed into said system (**See at least Col. 1 Lines 37 – 40**).

14. In regards to **claims 8 – 11 and 23 – 26**, the Examiner asserts that it is old and well known for search engines to provide a listing of websites that are relevant to the user's search query. That is to say, the user can define all of the appropriate search terms for the search engine to search for. As a result, if the user's search query consists of products, services, prices, content, publication, or any combination thereof

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the search engine would then process the search query and provide the user with all websites that are relevant to the search query.

In regards to **claim 12**, the Examiner asserts that online internet e-mail providers are old and well known in the art, such as Hotmail, Gmail, MSN, and etc. Further still, it is also well known for many companies to have a contact list consisting of e-mail, fax, or phone numbers. As a result, as explained above, as long as the search query exists somewhere on the Internet the search engine will search for it within its databases and provide them to a user. Further still, the Examiner also asserts that an e-mail address can consist of any alpha/numeric combination that has not been used, including a phone number. Thus, if a user's email address consisted of phonenumber@hotmail.com, for example, the search engine would then search for that specific search term.

15. In regards to **claim 13**, the Examiner asserts that it is old and well known for an e-mail message to be sent to multiple recipients and that a single recipient can have several e-mail accounts.

### ***Response to Arguments***

16. Applicant's arguments filed **6/23/2008** have been fully considered but they are not persuasive.

### **Rejection under 35 USC 101**

17. Rejection under 35 USC 101 has been withdrawn due to amendments.

### **Claim Objections**

18. Claim Objections have been withdrawn due to amendments



**Rejection under 35 USC 112, Second Paragraph**

19. Rejection under 35 USC 112 has been withdrawn due to amendments.

**Affidavit/Declaration**

20. The affidavit/declaration filed on 6/23/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the **Pant** reference.

Applicant's submitted **Composite Exhibit A** has will not be considered since it has not been properly presented to the Examiner. The applicant has failed to provide a proper declaration or IDS to allow for the presentation and use of **Composite Exhibit A**. As a result, any arguments that are presented using **Composite Exhibit A** as support will not be considered. Further still, applicant's argument that, "...even at present it is not old and well known" is not relevant since it does not provide sufficient reasoning of why it was not old and well known at the time of filing and fails to address the rejection provided above. In other words, just because it is not done at the present time does not mean that it was not done in the past.

**Rejection under 35 USC 103**

21. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

22. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

23. Regarding applicant's argument that Pant fails to disclose, "...any comparison of data regarding products or services provided by websites, or including software applications for correlating telephone numbers to domain names, must less doing both and also applying customizable criteria to render a directory. Pant relies on word searching in documents and other online content, which is not useful for telephone number queries."

However, it would have been obvious to one having ordinary skill in the art that a search query can consist of many different types of alpha/numeric search terms. That is to say, a search query can consist of words, numbers, symbols, and/or any combination thereof. As a result, the Examiner asserts that it is well known that a user who would be using an Internet search engine to look up the location of say, a fast food establishment within a certain area code would input **area code 703 and burgers**, for example. Further still, it is also well known for the URL of many websites to be the phone number of the business, such as **1-800-FLOWERS (1-800-356-9377)** or **1-800-MATTRES (1-800-628-8737)**. As a result, the Examiner notes that the act of claiming a specific search term, i.e. telephone number, is nonfunctional descriptive subject matter.

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Since **Pant** discloses the use of a search engine over the Internet and since it is well established that search terms can consist of various alpha/numeric combinations it would have been obvious that a telephone number can easily be substituted into the search query. Consequently, given the nature of how a search engine works it would have been realized by one having ordinary skill in the art that as long as the telephone number appears on a website the websites that contain the telephone number will appear in the search results. Moreover, an additional feature of a search engine is to also provide comparable websites that are associated with the search query (**see also Fig. 5 - 7 of Pant**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of **Pant** to use specific search terms, such as a telephone number, for when the user is searching for a specific site on the Internet.

24. Regarding the applicant's argument that, "Two examples that are distinguishable does not prove using telephone numbers as search queries was old and well known as of when the Applicant's invention was made," the Examiner disagrees. The Examiner asserts that only one example would have sufficed in the rejection and that the 3 provided examples (**area code 703 and burgers, 1-800-FLOWERS (1-800-356-9377) or 1-800-MATTRES (1-800-628-8737)**) were only used as a means of providing additional information to establish how well known the concept is.

25. In response to applicant's argument that **Pant** does not, "...gather and store data pertaining to products or services offered by websites or cross-reference telephone

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numbers and domain names, and use both customizable criteria to render a referential directory of selected sites that are comparable alternatives to each other”, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the Examiner once again asserts that **Pant** discloses a system and method wherein a search engine is used for searching for a user’s search query. Although, **Pant** does not disclose the use of a telephone number as the search terms for the search query it is asserted that the invention would still perform the steps of receiving a user’s search query, searching an index (directory) for websites that contain the search terms, and providing the results. The search engine does not care whether the search terms are just words, numbers, symbols, or a combination thereof. As long as the data (search terms) appear in a document on the Internet and comply with searching parameters the search engine will produce the requested results.

26. The applicant argues that, "...the invention as a whole does not constitute an obvious use of processing of "nonfunctional descriptive subject matter." The Examiner asserts that the mere act of storing, retrieval, matching, and displaying data is non-functional. In other words, the type of data add little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the data type.

***Conclusion***

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./  
Examiner, Art Unit 3689  
9/29/08

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689